



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,241	03/08/2005	Alexander Boldin	BOLDIN/102/PC/US	2845
2543	7590	04/15/2010		
ALIX YALE & RISTAS LLP 750 MAIN STREET SUITE 1400 HARTFORD, CT 06103			EXAMINER JOSEPH, DENNIS P	
			ART UNIT	PAPER NUMBER
			2629	
			MAIL DATE	DELIVERY MODE
			04/15/2010	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	Application No. 10/527,241	Applicant(s) BOLDIN, ALEXANDER	
	Examiner DENNIS P. JOSEPH	Art Unit 2629	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 31 March 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-25 and 27-30.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
Please see attached.  
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/Amr Awad/

Supervisory Patent Examiner, Art Unit 2629

The claim amendments have not been entered because of new issue/change in scope and a request for reconsideration is respectfully required to continue prosecution of the case. Thank you.

Applicant has noted that all of the limitations of Claim 1 are now present in Claim 29. However, while Claim 29 has changed in scope and new issue has been added, different than previous versions of Claim 29, there are still missing limitations and the claim still does not have substantially all the limitations of Claim 1.

As for Claim 29, Applicant is asked to better claim the "conveying of the signals" to be more in accordance with the specification. This is for 101 issues which arise if nonstatutory matter has been presented. A clear definition in the specification is required and examiner would appreciate Applicant noting where this support is. Thank you.

As for Applicant's arguments, examiner feels Applicant is importing too many limitations from the arguments and specification, but these have to be claimed for them to be given weight. Examiner does not see the hollow concave limitation, the neutral positioning of the hand (which Applicant uses to strengthen the resting position argument), the empty space aspects of the present invention, etc. These limitations, respectfully, need to be claimed, for them to be given weight.

Applicant also argues about Adler's thickness, but there is no claimed value for Applicant's own thickness in the claim language. Therefore, examiner does not see why this needs to be given weight. Please differentiate the present invention from the prior art by claiming an actual value or a range which Adler does not read on.

As for Applicant's arguments on the tangential movement, Adler does indeed teach of this. The dictionary definition of tangential means touching a surface at a point and Adler does indeed teach of touching the mouse as well as operating the mouse at a tangential angle to the surface. If Applicant has a special definition for the term (lexicographer), then please state this.

Also please note that the rejection is made under a 103, not a 102, so the movements and operation of the mouse are partially taught under the obviousness heading. At the very least, Adler suggests of operating the mouse in the claimed manner since he has substantially the same structure. Respectfully, this is all that is required under a 103 section. Examiner asks Applicant to better claim the present invention, including the limitations as discussed in the remarks, to differentiate the present invention from the Adler reference. Doing so will overcome the current rejection and pass the case to allowance.

Again, Applicant's amendments have not been entered and the arguments are also, respectfully, not persuasive. A request for reconsideration is respectfully required to continue prosecution of the case. Thank you.